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EXAMINER

CHANDLER, SARA M

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/805,485	<b>Applicant(s)</b> PUGH, JAMES B.	
	<b>Examiner</b> SARA CHANDLER	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01/31/08.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7,12-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7,12-17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's arguments and request for continued examination of application 09/805,485 (03/13/01) filed on 01/31/08.

### ***Claim Interpretation***

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. See MPEP 2106 II C. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result (e.g., "for \_\_\_\_\_"), but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result (e.g., "for \_\_\_\_\_"), but does not result in a

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structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as “*if, may, might, can could*”, as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as “*wherein, whereby*”, that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct

inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The claimed invention is directed to multiple statutory classes because it is a system that contains method steps.

The only structural component is the system itself and it is recited in terms of its functionality. The system “allows” (a) a user to create a merchant account ..and (b) a merchant to process a request with said ..for transaction processing quotes. However, the system (which we treated as an apparatus) fails to recite any structural component of the system which performs the one or more process steps. It can be stated that the entire system is presented in a narrative (system is recited as what process it allows but there is no structure shown), forms of payment and escrow system do not have any functionality.

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

### ***Claim Objections***

Claim 1 objected to because of the following informalities:

Claim 1 recites, “said system allowing a merchant to process a request with said processing center for transaction processing quotes.” Should this be -- said system

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allowing a merchant to process a request with said processing center for transaction processing quotes; -- (Note: The present claim has a period in the middle of the claim which is improper).

Claim 1 recites, "wherein said forms of payment is selected from the group consisting of;" Should this be -- wherein said forms of payment are selected from the group consisting of:" (Note: What follows is intended to be part of a markush group or a separate limitation?)

Claim 1 recites, "Zip codes;" Should this be -- zip codes -- ?

Claims 7,12 and 14 recite, "The system of Claim 1 further comprising;" Should this be -- The system of Claim 1 further comprising:" (Note: Punctuation issues)

Claim 17 recites, "said another type of shopping cart" Should this be -- said another shopping cart -- ? (Note: Consistent terminology should be used.)

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-3, 6-7, 12-17 and 19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 1** is rejected for the following:

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission

amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

Claim 1 is rejected under 35, U.S.C. 112, second paragraph, because none of the claim limitations have any functionality. Note: Applicant should revise "said system allowing". The language is passive and not required of the system. What is the claimed system programmed to do? (Note: Same problem with "allows" in claim 13).

Claim 1 recites the limitation "said merchant bank". There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites, "manual entered credit card, card present transaction using eConnect, eCashPad, PIN Debit transactions using same type of card present devices, on-line check, savings account drafts, money market checks, margin security check, on-line credit line pulls, wire transfers, sight drafts, letter's of credit, and similar forms of payment;"

Should this be -- manual entered credit card, card present transaction using eConnect or eCashPad, PIN Debit transactions using same type of card present devices, on-line check, savings account drafts, money market checks, margin security check, on-line credit line pulls, wire transfers, sight drafts and letter's of credit; --

The claim is indefinite because the phrase "eConnect, eCashPad" makes it unclear whether both are required or if they are alternative. The claim is drafted as a closed Markush group but applicant has included "and similar forms of payment" which are payment forms that are unknown and renders the claim indefinite. The term "similar" is a relative term which renders the claim indefinite. The term is not defined by

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the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being “selected from the group consisting of A,B and C.” See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925).

Claim 1 recites the limitations, “wherein all forms of payments outside of credit card are treated as an ACH transaction;”, “wherein said system comprises a device for placing each ACH transaction into said escrow account on behalf of a purchaser and said ACH transaction is held there until said merchant completes said transaction;” These limitations render the claim indefinite because it is unclear what is necessary to infringe the claim (a) a system or (b) a system used in the method and manner recited.

Claim 1 recites the limitations “forms of payment”, “said system further comprising an encryption algorithm” and “escrow system”. These are not tangible structural things. Thus, similarly “wherein said form of payment is selected from the group consisting of...” does not have structure

Claim 1 recites the limitation "said escrow account". There is insufficient antecedent basis for this limitation in the claim. (Note: There is prior reference to a plurality of escrow accounts (i.e., "an escrow system which comprises escrow accounts on behalf of each purchaser" but, it is unclear what specific escrow account is referred to.)



. Claim 1 recites "said system" however, it is unclear what system is referred to. (Note the claim refers to three different systems (i.e., "A system for providing financial transactions on the Internet comprising:"; "a computer system linked to the internet" and "an escrow system").

Claim 1 is indefinite because it is unclear whether applicant is claiming a system or process claim. The appears to be a hybrid claim because "allowing" steps are interpreted as process steps and forms of payment is also interpreted as "selecting forms of payments.." i.e. process step. On the other hand, a computer system and a merchant bank, an escrow system are structural components of an apparatus or a system.

**Re claim 3:** Claim 1 recites the limitation "wherein said banks include national syndicated banks, international banks and offshore banks". There is insufficient antecedent basis for this limitation in the claim. (Note: There single )

**Claim 12** recites the limitation "said escrow into a merchant account ". There is insufficient antecedent basis for this limitation in the claim. Should this be -- said escrow account into the merchant account -- ?

**Claim 15** is rejected for the following:

Claim 15 recites a limitation wherein merchants are notified of "processing center and interest rates of said banks" in line 13. It is unclear what the interest rates. (Should clarify that these interest rates correspond to the request for quote or otherwise indicate why they are provided0.

The “if” recited in “wherein if said user does not get a processing center quote” is optional or conditional language. There is no requirement if the user does get a processing center quote. See MPEP § 2106 II.(C).

“an ASP/e-commerce site programming organization downloads Internet service access processing engine and links this to an e-commerce site.” It is unclear what is meant by “this.”

For purposes of examination: The following limitation in claim 15 “wherein if said user does not get a processing center quote, an ASP/e-commerce site programming organization downloads Internet service access processing engine and links this to an e-commerce site” is interpreted as, If the user cannot get access to information, the information can be downloaded/obtained from somewhere else such as an external website.

**Claim 16** recites, “The method of Claim 15 wherein said shopping cart is selected from the group consisting of an Internet service access processor combined shopping cart, or another shopping cart or e-commerce existing platform.” The claim is indefinite because the claim appears to be directed to a Markush group of shopping carts but, it is unclear whether an e-commerce existing platform is a shopping cart. Also, the Markush is not in proper form.

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being “selected from the group consisting of A,B and C.” See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925).

Re Claim 16: It is unclear what is "said shopping cart. The claim depends from claim 15 which has two different shopping carts (i.e., an e-commerce shopping cart" and "a shopping cart"). It is unclear whether these are intended to be the same shopping cart or different shopping carts.

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3, 6-7 and 12-14** are rejected under 35 U.S.C. 102(e) as being anticipated by Morea, Pub. No. US 2002/0120537 A1.

**Re Claim 1:** Morea discloses a system for providing financial transactions on the Internet comprising:

a computer system linked to the Internet (See Morea, Abstract);

a merchant bank linked to a processing center (See Morea, fig. 12,402,204);

said system allowing a user to create a merchant account with said merchant bank (See Morea, fig. 12,402,204);

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said system allowing a merchant to process a request with said processing center for transaction processing quotes (See Morea, fig. 12,402,204); forms of payment (See Morea, fig. 14 "Payment Types") ; and an escrow system which comprises escrow accounts on behalf of each purchaser (See Morea, ¶ [0003],[0073];claim 47));

wherein said form of payment is selected from the group consisting of; manual entered credit card, card present transaction using eConnect, eCashPad, PIN Debit transactions using same type of card present devices, on-line check, savings account drafts, money market checks, margin security check, on-line credit line pulls, wire transfers, sight drafts, letter's of credit, and similar forms of payment (See Morea, Fig. 3, 92-payment methods);

wherein all forms of payments outside of credit card are treated as an ACH transaction (See Morea, Fig. 3, 92- ACH/EFT);

wherein said system comprises a device for placing each ACH transaction into said escrow account on behalf of a purchaser and said ACH transaction is held there until said merchant completes said transaction (See Morea, ¶ [0003],[0073], claim 47).

said system further comprising an encryption algorithm for encrypting a transaction (See Morea¶ [0121] [0121] Inherent attributes of encryption is that information is encrypted when it is loaded/entered and before transmission and the information is unable to be de-crypted until it is received. Encryption is security feature and it would defeat the purpose if the information could be tapped into during

transmission. Furthermore, it is impossible to de-crypt something before you receive or have it. See MPEP § 2112 [R-3]]);

said encryption algorithm taking a transaction and encrypting it as a purchaser loads data into a shopping cart payment process (See Morea ¶ [0121] [0121] Inherent attributes of encryption is that information is encrypted when it is loaded/entered and before transmission and the information is unable to be de-crypted until it is received. Encryption is security feature and it would defeat the purpose if the information could be tapped into during transmission. Furthermore, it is impossible to de-crypt something before you receive or have it. See MPEP § 2112 [R-3]]);

said encryption algorithm is only de-encrypted when said transaction reaches said processing center (See Morea ¶ [0121] [0121] Inherent attributes of encryption is that information is encrypted when it is loaded/entered and before transmission and the information is unable to be de-crypted until it is received. Encryption is security feature and it would defeat the purpose if the information could be tapped into during transmission. Furthermore, it is impossible to de-crypt something before you receive or have it. See MPEP § 2112 [R-3]).

**Re Claim 2:** Morea discloses the system of Claim 1 wherein said system matches a zip code of said merchant to banks having zip codes nearby and sends an application to said banks for a quote (See Morea, Fig. 13, Claim 53).

**Re Claim 3:** Morea discloses the system of Claim 1 wherein said banks include national syndicated banks, international banks and offshore banks (See Morea, ¶ [0003], [0031], [0041], [0071], Claims 10 and 36).

**Re Claim 6:** Morea discloses the system of claim 1 wherein a purchaser can interact with a processing center on-line in selecting alternative payment methods if said first form of payment chosen by a purchaser does not have available funds (See Morea, figs. 1-4).

**Re Claim 7:** Morea discloses the system of claim 1 further comprising; a foreign currency exchange for a purchaser if an ACH form of payment has been selected (See Morea, ¶ [0003], [0031], [0041], [0071], claims 10 and 36).

**Re Claim 12:** Morea discloses the system of claim 1 further comprising; said system electronically matching and clearing said transaction by moving funds out of said escrow into a merchant account (See Morea, ACH).

**Re Claim 13:** Morea discloses the system of claim 12 wherein said system provides notification to said purchaser that a time limit of said escrow has ended and allows said purchaser either to extend said escrow or request a refund of funds (See Morea, ¶ [0003], [0073]; claim 47).

**Re Claim 14:** Morea discloses the system of claim 1 further comprising; an accounting system that stores details of transactions for retrieval (See Morea, figs. 3-4).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-3, 6-7, 12-17 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Morea, US Pub. No. 2002/0120537.

**Re Claim 1:** Morea discloses a system for providing financial transactions on the Internet comprising:

a computer system linked to the Internet (See Morea, Abstract);  
a merchant bank linked to a processing center (See Morea, fig. 12,402,204);  
said system allowing a user to create a merchant account with said merchant bank (See Morea, fig. 12,402,204);  
said system allowing a merchant to process a request with said processing center for transaction processing quotes (See Morea, fig. 12,402,204);  
forms of payment (See Morea, fig. 14 "Payment Types") ; and  
an escrow system which comprises escrow accounts on behalf of each purchaser (See Morea, ¶ [0003],[0073];claim 47));  
wherein said form of payment is selected from the group consisting of;  
manual entered credit card, card present transaction using eConnect, eCashPad, PIN Debit transactions using same type of card present devices, on-line check, savings

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account drafts, money market checks, margin security check, on-line credit line pulls, wire transfers, sight drafts, letter's of credit, and similar forms of payment (See Morea, Fig. 3, 92-payment methods);

wherein all forms of payments outside of credit card are treated as an ACH transaction (See Morea, Fig. 3, 92- ACH/EFT);

wherein said system comprises a device for placing each ACH transaction into said escrow account on behalf of a purchaser and said ACH transaction is held there until said merchant completes said transaction (See Morea, ¶ [0003],[0073], claim 47).

wherein data is encrypted while it is being sent and wherein only the intended user can see the data in the de-crypted form (See Morea¶ [0121] [0121]).

Morea fails to explicitly disclose a system:

said system further comprising an encryption algorithm for encrypting a transaction;

said encryption algorithm taking a transaction and encrypting it as a purchaser loads data into a shopping cart payment process; and

said encryption algorithm taking a transaction and encrypting it as a purchaser loads data into a shopping cart payment process.

It is old and well-known in the art that information is encrypted when it is loaded/entered and before transmission and the information is unable to be de-crypted until it is received. Specifically it is old and well known to have a system: said system further comprising an encryption process for encrypting a transaction; said encryption process taking a transaction and encrypting it as a purchaser loads data into a shopping



cart payment process; and said encryption process taking a transaction and encrypting it as a purchaser loads data into a shopping cart payment process.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Morea to provide a system: said system further comprising an encryption algorithm for encrypting a transaction; said encryption algorithm taking a transaction and encrypting it as a purchaser loads data into a shopping cart payment process; and said encryption algorithm taking a transaction and encrypting it as a purchaser loads data into a shopping cart payment process.

One would have been motivated by security because it would defeat the purpose if the information could be tapped into during transmission. Furthermore, it is impossible to de-crypt something before you receive or have it.

**Re Claim 2:** Morea discloses the system of Claim 1 wherein said system matches a zip code of said merchant to banks having zip codes nearby and sends an application to said banks for a quote (See Morea, Fig. 13, Claim 53).

**Re Claim 3:** Morea discloses the system of Claim 1 wherein said banks include national syndicated banks, international banks and offshore banks (See Morea, ¶ [0003], [0031], [0041], [0071], Claims 10 and 36).

**Re Claim 6:** Morea discloses the system of claim 1 wherein a purchaser can interact with a processing center on-line in selecting alternative payment methods if said first form of payment chosen by a purchaser does not have available funds (See Morea, figs. 1-4).

**Re Claim 7:** Morea discloses the system of claim 1 further comprising; a foreign currency exchange for a purchaser if an ACH form of payment has been selected (See Morea, ¶ [0003], [0031], [0041], [0071], claims 10 and 36).

**Re Claim 12:** Morea discloses the system of claim 1 further comprising; said system electronically matching and clearing said transaction by moving funds out of said escrow into a merchant account (See Morea, ACH).

**Re Claim 13:** Morea discloses the system of claim 12 wherein said system provides notification to said purchaser that a time limit of said escrow has ended and allows said purchaser either to extend said escrow or request a refund of funds (See Morea, ¶ [0003], [0073]; claim 47).

**Re Claim 14:** Morea discloses the system of claim 1 further comprising; an accounting system that stores details of transactions for retrieval (See Morea, figs. 3-4).

**Re Claim 15:** Morea discloses method for providing financial transactions on the Internet comprising (See Morea, method steps of Figs. 1-5):  
logging on to the Internet (See Morea, Fig. 4- Diagram connecting Buyer and Seller to the internet);  
providing a shopping cart selection and merchant account application (See Morea Fig. 4- Net Marketplace; Fig. 7);  
linking an e-commerce shopping cart to a processing center (See Morea, Fig. 7 “process credit card payments for your webstore”);  
choosing a shopping cart (See Fig. 4- Net Marketplace);  
creating a merchant account (See Morea, Fig. 7);

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providing merchant account information (See Morea, Fig. 7);  
submitting said merchant account information to a bank (See Morea, Fig. 12);  
submitting said merchant processing request to processing centers for transaction processing quotes (See Morea, Fig. 2 -Processing component; Fig. 6- Transaction Processing component);  
notifying said merchant of banks who approved said merchant processing request and processing center and interest rates of said banks (See Morea, Figs. 3,4); and  
selecting said bank and processing center (See Morea, Figs. 3,4);  
providing a quote to said user from said processing center (See Morea, Figs. 3,4, [0030]);  
wherein if said user does not find what they need, the user is linked to external provider (Morea, Figs. 1-5, [0031] [0032]).

Morea fails to explicitly disclose a method:

wherein if said user does not get a processing center quote, an ASP/e-commerce site programming organization downloads Internet service access processing engine and links said user to an e-commerce site.

It is old and well known in the art to provide users with information such as price quotes, and if unable to do so to link users to other sites with the relevant information. Specifically, it is old and well-known to disclose a method wherein if said user does not get a processing center quote, an ASP/e-commerce site programming organization downloads Internet service access processing engine and links said user to an e-

commerce site. For example, this is commonly used by companies such as Lending Tree, Priceline etc.

As suggested by Morea, one would have been motivated to create a trusted environment for user that is integrated with the internet marketplace.

**Re Claim 16:** Morea discloses the method of claim 15 wherein said shopping cart is selected from the group consisting of an Internet service access processor combined shopping cart, or another shopping cart or e-commerce existing platform. (See Morea, Figs. 7-11)

**Re Claim 17:** Morea discloses the method of claim 16 wherein said another type of shopping cart has a payment processing platform (See Morea, Figs. 7-11).

**Re Claim 18:** Morea discloses the method of claim 15 wherein if said user does not get a processing center quote, an ASP/e-commerce site programming organization downloads Internet service access processing engine and links this to an e-commerce site (See Morea, Fig. 5).

**Re Claim 19:** Morea discloses the method of claim 18 wherein said Asp/e-commerce site programming organization performs a transaction test (See Morea, Fig.5).

Claims 1-3, 6-7, 12-17 and 19 apply a known technique to a known method/system ready from improvement to yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

**101**

Applicant's amendment was non-responsive. See analysis supra.

**112**

Applicant's amendment was non-responsive. See analysis supra.

**102/103**

Applicant argues Morea does not disclose a system: said system further comprising an encryption process for encrypting a transaction; said encryption process taking a transaction and encrypting it as a purchaser loads data into a shopping cart payment process; and said encryption process is only de-encrypted when said transaction reaches said processing center. Applicant's argument has been fully considered but is not persuasive.

These features are inherent to the Morea reference. Inherent attributes of encryption is that information is encrypted when it is loaded/entered and before transmission and the information is unable to be de-crypted until it is received. Encryption is security feature and it would defeat the purpose if the information could be tapped into during transmission. Furthermore, it is impossible to de-crypt something before you receive or have it. See MPEP § 2112 [R-3])). These features are old and well-known to one of ordinary skill in the art for the reasons cited and one would have been motivated modify Morea and explicitly disclose the limitations for the reasons cited.

Applicant argues Morea does not disclose a method said method further comprising notifying said merchant of banks who approved said merchant processing request and processing center and rates of said banks.

Notifying parties (e.g., buyer, seller, user etc.) regarding information is disclosed in Morea. Morea further teaches providing banking information to the parties. See citation supra.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Further, none of the figures shown in Morea show that they can be linked to an external provider.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Remarks***

Applicant had trouble conveying the claimed invention (i.e., system and it's required structural components; process and interrelationship between process steps).

Applicant's specification seems to support two distinct processes. (1) merchant account processing. Figs. 3a and 3b, pgs. 6-7 of specification (2) Internet purchaser transaction processing. Figs. 4a-4d, pgs. 7-9 of applicant's specification.

Since applicant is entitled to one invention in a patent application, applicant may wish to pursue one of these as a process claim in the instant application and pursue the other process in another application. See Chapter 800 of MPEP.

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Below is what is understood to be applicant's "merchant account process", which may serve as a starting point for drafting this process claim. This should not be seen as suggested or preferred language and applicant may modify the language as needed. Language in brackets or parenthesis are unclear from applicant's claims and specification. Applicant should ensure that no 112, grammar problems exist prior to submitting the next office action.

selecting, by a user (purchaser/customer, merchant ???) via a merchant shopping cart selection and merchant account application 200, a shopping cart,  
wherein said shopping cart is selected from a group consisting of: an internet service access processor combined shopping cart 220 and a competitor shopping cart 230; (pg. 6, Fig. 3a)

when said internet service access processor combined shopping cart 220 is selected, creating a merchant account 260; (pg. 6, Fig. 3a)

when said competitor shopping cart 230 is selected, determining whether a payment processing platform 240 exists, and  
if said payment processing platform 240 exists, creating a merchant account 260  
and if said payment processing platform 240 does not exist, terminating a sale 250; (pg. 6, Fig. 3a)

once said merchant account 260 is created, a merchant proceeds by either: providing merchant account information online 270 or completing an online merchant account form 290; (pg. 7, Fig. 3a)

when said merchant provides the merchant account information online 270,  
sending a merchant processing request to a processing center for a quote 280;  
(pg. 7, Fig. 3a)

when said merchant completes the online merchant account form 290,  
submitting said merchant account form to [at least one ???] merchant bank 300,  
and sending a merchant processing request to a processing center for a quote 310; (pg. 7, Fig. 3b)

[if a quote is received from the processing center in response to the merchant account processing request ???],

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notifying said merchant of [at least one ???] bank that approved the processing request, the processing center and rates 320 (What is this? Is it a bank rate corresponding to a given request for quote?); (pg. 7, Fig. 3b), and selecting, by said merchant, one of the at least one bank that approved the processing request and the processing center; (pg. 7, Fig. 3b) and

[if a quote is not received from the processing center in response to the merchant account processing request or after said merchant selects one of the at least one bank that approved the processing request and the processing center ???],  
[downloading, by a ASP/e-commerce site programming organization, internet service accessing processing engine and links to e-commerce site 34.??? ] (pg. 7, Fig. 3b).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references pertain to e-shopping.

("5812668"|"5825881"|"5850446"|"5889863"|"5931917"|"5943424"|"5978840"|"5983208"|"5987132"|"5996076"|"6002767"|"6026379"|"6041123"|"6072870"|"6119105"|"6163772"|"6178409"|"6253027"|"6304915"|"6324525"|"6363363"|"6373950"|"7127427").P  
N.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC  
/JAGDISH N PATEL/  
Primary Examiner, Art Unit 3693